



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/749,865

12/31/2003

Sven Schwerin-Wenzel

103580.00020

6320

54975

7590

02/26/2009

HOLLAND & KNIGHT LLP

10 ST. JAMES AVENUE

11th Floor

BOSTON, MA 02116-3889

EXAMINER

LONG, FONYA M

ART UNIT

PAPER NUMBER

3689

MAIL DATE

DELIVERY MODE

02/26/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/749,865	Applicant(s) SCHWERIN-WENZEL ET AL.	
	Examiner FONYA LONG	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 21-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 21-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This communication is a third Non-Final Office Action in response to communications received on December 12, 2008. Claims 1 and 2 have been amended. Claims 3-20 have been canceled. Claims 21-36 have been added. Claims 1, 2, and 21-36 are currently pending and have been addressed below.

Response to Amendment

1. Applicant's amendments to the claims are sufficient to overcome the 101 and 112 2nd rejections as set forth in the previous Office Action.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1, 2, and 21-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. With respect to

Art Unit: 3689

claims 1, 2, and 21-27, the claim language does not include the required tie or transformation and thus is directed to nonstatutory subject matter.

Examiner recommends placing the computer limitation in the body of the claim. For example, stating providing a first computer interface; providing a second computer interface; and providing one or more tools on a computer.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 2, 21, 23, 24-27 and 28-30, 32-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Marpe et al. (6,671,692).

As per Claims 1 and 28, Marpe et al. discloses a method and article comprising:

providing a first interface for a first organization adapted to plan a project with a resource management capability and a time management capability (Col. 18, Line 25-Col. 20, Line 6, discloses an "Executive Dashboard" interface that allows users to plan milestones according to time and resources);

providing a second interface for a second organization adapted to provide collaborative capabilities to plan the project with said resource management and said

Art Unit: 3689

time management, said first and second interface forming a collaborative workspace between said first organization and said second organization (Col. 33, Lines 37-57, discloses a "Decision Management Tool" allowing users to collaboratively plan and make decisions regarding a merger project); and

providing one or more tools graphically displayed on at least one of said interfaces adapted to allow a user to exchange merger information and aid in collaboration with said plurality of said organizational members (Col. 47, Lines 50-64, discloses an "M&A Planning Guide" which allows its users both client and [internal] personnel and other interested users to share exchange information via "an interactive web-based tool");

wherein said one or more tools provide one or more graphically displayed features including:

a feature for defining one or more milestones; a feature for choosing one or more resources to assign to one or more tasks or said one or more milestones, a feature for selecting when said one or more tasks is scheduled for completion, and a feature for detecting and displaying interdependencies between tasks (Col. 18, Lines 35-48, discloses determining (i.e. defining) a plurality of milestones associated with the merger or acquisition).

As per Claims 2 and 29, Marpe et al. discloses wherein at least one of said first interface and second interface further comprises:

a communication interface (Col. 33, Lines 37-57, via Decision Management Tool wherein information is communicated among the users via a bulletin board accessible via the network);

an information sessions interface (Col. 18, Lines 25-48, via Executive Dashboard which provides summary of data relating to a merger via an interface to a database. A plurality of issues relating to a merger are identified; and a plurality of milestones associated with the merger are determined in operation); and

one or more interface for a manager to communicate merger information with one or more employees (Col. 33, Lines 37-57, via Decision Management Tool wherein information is communicated among the users via a bulletin board accessible via the network).

As per Claims 21 and 30, Marpe et al. discloses wherein said merger information further comprises:

progress information regarding said merger (Col. 18, Lines 35-48, via progress of the projects is gauged in terms of a plurality of criterion and the issues, the milestones, and the gauged progress of the projects are outputted in operation);

questions and answers between said employees and said manager (Col. 9, Lines 48-57, via M&A Engine utilizes discussion databases to submit and/or answer issues, questions, and topics); and

communications between said employees and said manager, wherein said interfaces are adapted to allow multiple users to access and view said interfaces (Col. 9, Lines 41-47, via M&A Engine allows merger/acquisition participants to access

Art Unit: 3689

information and deliverables, contribute knowledge, and conduct informal conversations).

As per Claims 23 and 32, Marpe et al. discloses said at least one tool includes a collaboration tool (Col. 9, Lines 21-Col. 10, Line 4, discloses M&A being used as a collaboration tool) adapted to permit a user to create:

chat sessions and other interactive discloses (Col. 14, Line 59-Col. 15, Line 8, via Bulletin Board system that allows users to chat online with other users and send email),

online meetings (Col. 9, Line 58-Col. 10, Line 4, via users are able to conduct "virtual meetings"),

synchronized browsing (Col. 1, Lines 6-9, via browsing data using a data browser),

checklists for financial objectives with deadlines and specific individuals who are responsible for said checklists, and

sub-checklists for related actions (Col. 26, Lines 15-Col. 27, Line 35, via a List of Key Milestones having an individual responsible for the milestones and a deadline (via scheduled end).

As per Claims 24 and 33, Marpe et al. discloses said interfaces are connected to a source system, wherein said interfaces and said source system communicate with network communication interfaces of a base system using a markup language (Col. 9, Lines 22-40, via M&A Engine is stored on a centralized server which may be accessed over a network. Col. 7, Line 63-Col. 18, Line 19, discloses the invention utilizing

HyperText Markup Language (HTML) to implement documents on the Internet together with a general-purpose secure communication protocol for a transport medium between the client and a company).

As per Claims 25 and 34, Marpe et al. discloses said communication interfaces include one or more of enterprise connector interfaces, internet communication interfaces, an encapsulated postscript interfaces, and interfaces that provide remote function call capability (Col. 15, Lines 9-17, via Bulletin Board system (BBS) allows people to call from their computers and post and receive messages).

As per Claims 26 and 35, Marpe et al. discloses said interfaces further providing graphical display features for a stakeholder to: arrange meetings (Col. 9, Line 58-Col. 10, Line 5, via conduct "virtual meetings" via the M&A Engine discussion database), start discussion threads (Col. 15, Lines 41-56, via a Discussion Database which includes a broad topic field having Discussion Groups relating to specific subject areas), personalize panels for individual tasks, deliverables and meetings (Col. 15, Lines 18-32, via BBS used for posting messages of a particular group of users who have similar interests).

As per Claims 27 and 36, Marpe et al. discloses providing a search query interface in at least one of said first and second interfaces comprising one or more search fields in the interface that allow a user to enter a search parameter for at least one merger organization, wherein the search parameter comprising an attribute of an activity, a group name, a group alias, a group administrator, a qualification, an interest, and a profile of an individual (Col. 23, Line 41-Col. 24, Line 7, discloses allowing users

Art Unit: 3689

to search for one or more status reports in the workbench database using a specified search criteria (i.e. search parameter)).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 22 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marpe et al. (6,671,692) and Vogt et al. (7,159,178).

Marpe et al. discloses said interfaces further including:

archived question responses (Col. 9, lines 22-57, via M&A Engine providing questions and answers to the question pertaining to a merger. Col. 47, Lines 51-54, discloses a M&A Planning Guide which allows user to review and update answers to submitted questions), and

a menu of various template types and formats (Col. 17, Lines 55-57, via allows users to access templates, create, store, and retrieve documents).

However, Marpe et al. fails to explicitly disclose interactive polls, questionnaires, and archived polls.

Vogt et al. discloses a browser-enable collaboration system with the concept of interactive polls, questionnaires, and archived polls (Col. 4, Line 42-Col. 5, Line 12; Col.

Art Unit: 3689

7, Line 36-Col. 8, Line 16, discloses providing online polls and questionnaires they may be accessed by a plurality of users and providing poll responses to a plurality of users).

Therefore, from the teaching of Vogt et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system for facilitating the navigation of data of Marpe et al. to include interactive polls, questionnaires, and archived polls as taught by Vogt et al. in order to gain insight and opinions of individuals in order to achieve specific objectives.

Response to Arguments

8. Applicant's arguments filed December 12, 2008 have been fully considered but they are not persuasive.

As per Claims 1, 2, and 21-36, Applicant's arguments are based on the amended and newly added claimed limitations. Applicant's arguments have been addressed in the rejected noted above based on the amended and newly added claims.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FONYA LONG whose telephone number is (571)270-5096. The examiner can normally be reached on Mon-Thur 7:30am-6:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone

Art Unit: 3689

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. L./

Examiner, Art Unit 3689

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689
2/20/09